

## **Remarks**

### **I. Introduction**

This response is submitted in reply to the outstanding Office Action mailed February 17, 2010. Claims 1-20 are pending. Claims 1-5 and 12 stand rejected. Claims 6-11 and 13-20 are withdrawn from consideration.

Claims 1-5 and 12 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter.

Claims 1-3 and 5 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter Applicant regards as the invention.

Claims 1-2, 4 and 12 were rejected under 35 U.S.C. § 103(a) as being obvious in view of U.S. Patent Appl. Publication No. 2003/0191721 ("Fiammante") in combination with U.S. Patent Appl. Publication No. 2001/0037264 ("Husemann"), with an Official Notice also being taken in connection with Claims 1 and 12.

Claim 3 was rejected under 35 U.S.C. § 103(a) as being obvious in view of Fiammante, Husemann and in further combination with U.S. Patent Appl. Publication No. 2002/0198849 ("Piikivi").

Claims 1-3 and 5 were amended and new claims 21-24 have been added. The amendments and new claims raise no new material issues and are fully supported by the originally filed application. Applicant respectfully traverses the rejections of the claims.

### **II. Response to Rejections under Section 101**

Claims 1-5 and 12 were rejected under 35 U.S.C. § 101 as being directed to non-statutory subject matter. Applicant respectfully traverses these rejections.

Independent Claim 1 recites "[a]n electronic transaction system ... comprising: a transaction processor ...." There is no reasonable interpretation of an electronic system having a processor that encompasses a human being. An electronic system, comprising a transaction processor, must be a machine. Applicant also notes for the record that the Examiner seems to recognize this fact, since the Examiner did not mention the "transaction processor" when rejecting Claim 1 under Section 101.

Moreover, the rejected recitations of Claim 1, namely the electronic transaction system's "message sender", "transaction history sender", "certifier" and "service provider", are all shown in Applicant's specification and drawings as being part of a network server. Likewise, if those claim recitations are considered in light of the specification and drawings, there is no reasonable interpretation that would encompass a human being.

Claim 12 was amended to recite "providing a service, with a transaction processor, to the transaction terminal according to the transaction when the transaction history is verified." The transaction processor is a machine that accomplishes a step of the method. For at least this reason, Claim 12 is tied to another statutory class, namely a machine.

Additionally, Claim 12 recites "An electronic transaction method ...." "An electronic transaction method" may only be accomplished by a machine or other electrical devices, and cannot be accomplished by humans or other biological beings without using a machine.

For at least these reasons, independent Claims 1 and 12 are directed to statutory subject matter. Claims 2-5 depend on Claim 1 and are, therefore, also directed to statutory subject matter. Accordingly, Applicant respectfully requests that the rejections under Section 101 be withdrawn.

### III. Response Rejections under Section 112

Claims 1-3 and 5 were rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter applicant regards as the invention. These rejections are respectfully traversed in view of the amendments being made to the claims.

Independent Claim 1 recites "[a]n electronic transaction system ... comprising: a transaction processor ...." A transaction processor is a type of processor, which is known to those skilled in the art as being a machine. Applicant also notes that the Examiner seems to recognize this, as evidenced by the recitation of the "transaction processor" not being rejected as a possible software module. As a result, Claim 1 includes at least one recitation, namely the recitation of the "transaction processor," that is accomplished by a machine, and distinctly claims and particularly points out what applicant regards as the invention.

Claims 2, 3 and 5 were also rejected as being indefinite as failing to be sufficiently precise. More specifically, Claims 2, 3 and 5 were rejected as allegedly reciting “both an apparatus and a method for using said apparatus ....” Applicant has amended Claim 2, 3 and 5 to recite each component of the apparatus being “configured to” perform an action, as opposed to being “for” performing an action. In this regard, Claims 2, 3 and 5 will provide competitors with an accurate determination of the “metes and bounds” of the protection involved. Applicant has also amended Claim 1 to avoid any potential, new rejections similar to those currently issued against Claims 2, 3 and 5.

Accordingly, Applicant respectfully requests that these rejections be withdrawn in view of the forgoing remarks and amendments to Claims 1-3 and 5.

### III. Response Rejections under Section 103

Claims 1, 2, 4 and 12, including independent Claims 1 and 12, were rejected 35 U.S.C. § 103(a) as being obvious in view of Fiammante and Husemann. Official Notice was also taken to complete the rejections of independent Claims 1 and 12. Claim 3 was rejected under Section 103(a) as being obvious in view of Fiammante, Huseman and Piikivi. Applicant respectfully traverses these rejections and the Office Notice. Applicant also notes for the record that Claim 5 was not rejected as being obvious.

Independent Claims 1 and 12 are generally directed to a transaction being requested at a transaction terminal (e.g., personal computer), receiving a transaction history and a mobile phone number from the transaction terminal, transmitting the transaction history to a certification mobile terminal (e.g., cellular phone), receiving a digitally signed transaction history from the certification mobile terminal, verifying the digitally signed transaction history, and then providing, to the transaction terminal, a service corresponding to the original transaction. *See* Applicant’s Claims 1 and 12, and paragraphs [0038] and [0039]. In this regard, a transaction request is received and a transaction history is used to provide a service to fulfill the request for the transaction.

Fiammante associates communication devices to secure a commercial transaction over a network. *See* Fiammante, abstract. Husemann enables a customer to use a mobile telephone to order deliverables from a merchant system. *See* Husemann, abstract.

The Examiner suggests that Fiammante shows a “transaction history” being received, transmitted, and then received again as digitally signed. Applicant respectfully disagrees. Fiammante does not show or otherwise suggest a transaction history, let alone receiving, transmitting, and/or receiving a digitally signed transaction history. In contrast, a transaction in Fiammante is initiated by a PC and the same transaction content is subsequently sent to a mobile phone for validation and signature. *See, e.g., Fiammante, paragraph [0031] and FIG. 2.* The “transaction content” of Fiammante is not historical, but is currently relating to the ongoing transaction. Fiammante’s actual transaction content is validated and digitally signed, whereas Applicant’s claims recite content relating to historical transaction(s), namely “transaction history,” being digitally signed.

In addition to failing to show “transaction history,” none of the cited documents show or otherwise suggest “receiving a digitally signed transaction history from the certification mobile terminal” (e.g., cellular phone) and then “providing a service, with a transaction processor, to the transaction terminal according to the transaction after verifying the digitally signed transaction history.” Applicant’s independent Claim 12 (and Claim 1 includes similar recitations). In contrast to what Applicant claims, Fiammante transmits, signs and verifies the actual “transaction content” that is to be executed, as opposed to transmitting, signing and verifying a transaction history that is different than the transaction requested.

Husemann does not mention digital signatures, let alone receiving a digitally signed transaction history and providing a service corresponding to a transaction after verifying the digitally signed transaction history.

Applicant, therefore, respectfully submits that independent Claims 1 and 12 are patentable for at least the above reasons, namely because none of the cited documents show or otherwise suggest: (1) a “transaction history” being received, transmitted, and/or received as digitally signed; or (2) verifying a digitally signed transaction history to provide a service corresponding to a transaction that was requested.

Although Applicant submits that the currently pending claims are patentable for at least the above reasons, Applicant has also amended independent Claims 1 and 12 to expedite allowance by more particularly pointing out and distinctly claiming the subject matter Applicant regards as the invention. Claims 1 and 12 have both been amended to recite

the “transaction history [is] for settling the transaction provided by the user ...” and Claim 1 has been further amended to recite, “wherein the transaction processor inquires about a certification method for settling the transaction according to the request provided by the transaction terminal and receives the transaction history with the mobile phone number from the transaction terminal when the transaction terminal selects a digital certificate based certification.”

For at least the foregoing reasons, independent Claims 1 and 12 are patentable over the combination of Fiammante and Husemann. Since rejected Claims 2-4 depend from and necessarily include all of the recitations of independent Claim 1, the cited documents, whether taken alone or in combination, do not teach or suggest the systems of Claims 2-4 for at least the same reasons as described above in conjunction with independent Claim 1. (“If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious.” *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); MPEP § 2143.) Accordingly, it is therefore submitted that the 35 U.S.C. § 103(a) rejections of Claims 1-4 and 12 have been overcome. Similarly, new Claims 21-24 are allowable for at least the same reasons, as new Claims 21-24 depend on allowable independent Claim 12. Dependent Claim 5 is allowable for the same reasons and further evidenced by the fact Claim 5 was not rejected as being obvious.

Lastly, while Applicant acknowledges that in certain, very limited, circumstances an Examiner may take “Official Notice” of facts under MPEP § 2144.03 where such facts are “capable of instant and unquestionable demonstration as being well-known”, Applicant hereby traverses each finding of Official Notice. Particularly, it was not well known or of common knowledge to provide a transaction history to a certification mobile terminal after the certification mobile terminal receives the message and accesses the system. To the contrary and as discussed above, providing a transaction history (as opposed to providing transaction content) and having the certification mobile terminal respond accordingly, is a patentable improvement over the cited documents. Therefore, Applicant further requests that one or more prior art references be produced to support any finding that the claim recitations acknowledged to be missing from Fiammante, Husemann and the other documents of record were well known or of common knowledge at the time that the present application was filed.

IV. Conclusion

In view of the remarks presented above, Applicant submits that the present application is in condition for allowance. As such, the issuance of a Notice of Allowance is therefore respectfully requested. In order to expedite the examination of the present application, the Examiner is encouraged to contact Applicant's undersigned attorney in order to resolve any remaining issues.

It is believed that no extensions of time or other fees are required. However, in the event that any additional petitions or fees are required to allow consideration of this Reply, such extensions of time are hereby petitioned under 37 CFR § 1.136(a), and any fee required therefore (including fees for net addition of claims) is hereby authorized to be charged to Deposit Account No. 16-0605.

Respectfully submitted,



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